

Nos. 16,410 16,411

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

Appeal No. 16,410

HARRY A. PURSCHE,

Appellant,

vs.

ATLAS SCRAPER AND ENGINEERING CO., a corporation,

Appellee.

Appeal No. 16,411

ATLAS SCRAPER AND ENGINEERING CO., a corporation,

Appellant,

vs.

HARRY A. PURSCHE,

Appellee.

APPELLEE'S BRIEF FOR THE PARTY HARRY A. PURSCHE.

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APPELLEE'S BRIEF FOR THE PARTY HARRY A. PURSCHE.

Introduction.

This is the second brief filed for the party Harry A. Pursche. The first brief for Pursche (17 pages) was filed for Pursche as Appellant; the present brief is filed for Pursche as Appellee and relates to the points raised by Atlas Scraper and Engineering Co. in its opening brief (208 pages). The "jurisdiction" statement as well as the "Nature of the Controversy," "The Parties," and "The Pleadings," are set forth in the first brief for Pursche as Appellant. The "Abstract of the Cases" as set out on pages 3 and 4 of the Atlas opening brief is accurate, but the remainder of the Atlas brief is devoted to argument.

History of Development of the Pursche Two-Way Plows.

Pursche is a farmer. For many years prior to 1947 he farmed substantial acreages in Southern California raising irrigated truck garden crops on a large scale basis. Such crops require that the land be maintained substantially flat for proper irrigation and this is best accomplished by the use of a "two-way" or "rollover" plow having both right-hand and left-hand plowshares. Such plows throw earth from the furrows in the same direction eliminating dead furrows and gullies which interfere with irrigation [Find. of Fact 5, R. 69]. For many years prior to Pursche's inventions there existed a need in the plowing art of a practical and successful two-way or roll-over plow which could be easily controlled by the operator and which would plow deep enough actually to turn the soil and not merely scrape the surface of the ground [Find. of Fact 21, R. 24]. The only large two-way plow commercially available was a Moline Tumblebug plow [R. 1632] with a maximum plowing depth of about 11 inches. In that plow the right-hand and left-hand plowshares were mounted to turn about a transverse axis and rotation was accomplished, after manual tripping of a latch, by drag of plows in the ground while the plow was pulled forward by the tractor and the plowshares "tumbled" end for end.

Pursche set out to devise a two-way plow in which both the lifting and turning operations of the plow carrier could be positively and independently controlled by the tractor operator without leaving the seat of the tractor and without requiring any forward movement of the tractor or plow. Pursche also sought to provide maximum maneuverability by close coupling the plow parts

to reduce the overall length, in order to simplify turn-around operations at the headlands. Pursche also set out to produce a heavy duty two-way plow with a minimum number of parts but with greater strength and rigidity than plows commercially available, capable of relatively deep plowing up to 20 inches [R. 201].

The Pursche invention of the basic '090 patent [R. 1548] succeeded in achieving all of these objects. The invention as defined in the claims of that patent comprises the combination of a longitudinal beam having a cross-beam fixed to its forward end, a plow carrier for right- and left-hand plows mounted to turn on the longitudinal beam, and a power cylinder assembly on the crossbeam acting through a power transmitting connection to revolve the plow carrier in either direction. This combination of parts comprises the core of the '090 invention and from it are derived the attributes of positive independent control of both lifting and turning as well as the short coupled feature for maximum maneuverability [R. 268].

The disclosure of the '090 patent shows a large two-way plow personally constructed by Pursche and completed in April 1947. The plow has four right-hand plowshares and four left-hand plowshares. [Find. of Fact 6, R. 70].

At the time of the trial the plow was still in commercial use and was demonstrated to the Trial Court in a field test. [See photographs Exs. 25-A to 25-I, incl.]

The other four Pursche patents in suit are each based on other plows personally constructed by Pursche and relate to subsequent developments and improvements. The '091 patent is directed to a combination including an im-

proved form of swinging tongue which permits direct application of draft forces directly to the longitudinal beam, thereby reducing the draft force stresses in the remainder of the frame. The '089 patent relates to a combination including an "A" frame mounting for the wheel arm cylinders, thereby providing a direct acting hydraulic power connection between the frame and the wheel arms to form a compact unit and eliminating intermediate parts between the hydraulic cylinder assembly and the respective wheel arms. The '284 patent relates to the basic design feature as specifically applied to tractor mounted plows, thereby producing a close coupling connection to minimize rearward extension of the plow parts and thereby minimize "bucking" of the front end of the tractor. The '786 patent relates to a tractor mounted two-way plow for a tractor having draft links which are lifted under hydraulic power, as well as providing a construction wherein the weight of the two-way plow assembly is effective to assist in turning the plow carrier on the longitudinal beam of the plow frame.

The foregoing history of the development of the Pursche two-way plows is set forth in the Findings of Fact Nos. 5 to 17 and 21 [R. 69-74].

The Pursche-Atlas License Agreement April 3, 1948 to July 13, 1952.

The several two-way plows which had been personally constructed by Pursche and used on his ranches were turned over to Atlas for measurement and study by its engineers [R. 74, 1234]. Pursche spent considerable time in conferences with Atlas' designers [R. 265, 1234] and certain features of the '090, '089 and '091 patents were embodied in an Atlas two-way plow shown in Exhibit 18 [Find. of Fact 28, R. 76].

The Pursche-Atlas license agreement and the activities of the parties pursuant thereto are set forth in Findings 18, 19, 20 and 22-28 [R. 74-76]. Contrary to the statement on page 9 of the Atlas brief, Atlas had never built a two-way plow nor any kind of plow prior to the signing of the license agreement with Pursche [Find. of Fact 18, R. 74]. During the period of the Pursche-Atlas license agreement Atlas paid Pursche in excess of \$75,000.00 in royalties [Find. of Fact 18, R. 74].

Prior to termination of the license agreement on July 13, 1952 Atlas held out to the trade and to the purchasing public that the two-way rollover plow which it offered for sale was the development and invention of Pursche [Find. of Fact 84, R. 90]. Pursche went on field trips in sales promotion efforts with the president of Atlas [R. 261, 273-289] and was introduced by him as the inventor of the Atlas plows [R. 1211].

Atlas cancelled the license agreement as permitted in Paragraph XIII thereof [R. 1654] on the ground that "manufacture and sale of devices under this agreement is not profitable," but Atlas continued to manufacture and sell the same devices employing the licensed inventions [R. 75]. Moreover, Atlas continued the manufacture and sale of substantially the same plows after issuance of the patents in suit to Pursche and without payment of royalties. The first group of these patents issued on January 13, 1953, six months after the effective date of the cancellation of the license agreement.

The Inventions of the Pursche Patents in Suit.

“The Pursche Patent No. 2,625,090 in suit overcame the problem in the two-way roll-over plow art in providing a new combination of a frame, a longitudinal beam fixed on the frame and extended rearwardly, a plow carrier mounted to turn on the longitudinal beam and provided with right- and left-hand plows, and a power developing hydraulic cylinder assembly on the frame acting through a power transmitting connection to revolve the plow carrier in either direction, thereby establishing a close coupled assembly in which the functions accomplished are more than the sum of the functions of the separate elements.” [Find. of Fact 42, R. 79].

“The elements of the combinations of all claims of Patent No. 2,625,090 with the exception of Claim 1, perform an additional and different function in combination than they perform out of combination, to wit: they provide a close coupling relationship between the frame, plow carrier and hydraulic cylinder assembly which enables the operator to turn the carrier independently of forward motion and independently of the raising and lowering action, and provides quick entry and exit of plows with relation to the land, with the result that the space required at the headlands for turn-around is substantially decreased with relation to prior art devices.” [Find. of Fact 44, R. 79].

“The elements of the combinations of Claims 12, 13, 14, 15 and 16 of Patent No. 2,625,089 perform additional and different functions in combination than they perform out of the combination, to wit: they provide a direct acting hydraulic power con-

nection between the frame and the wheel arms to form a compact unit eliminating intermediate parts between the hydraulic cylinder assemblies and their respective wheel arms.” [Find. of Fact 42, R. 79].

“The elements of the combinations of Claims 6, 7, 8, 9, 14, 15 and 22 of Patent No. 2,625,091 perform additional and different functions in combination than they perform out of combination, to wit: they provide direct application of draft force directly to the longitudinal beam which supports the plow carrier thereby reducing draft force stresses in the remainder of the frame, and they provide for mounting scraper blades on the plow carrier in advance of the plows so that trash may be cut by the scraper blades and buried by the plows in a single plowing operation and with either right-hand or left-hand plows in operative position.” [Find. of Fact 45. R. 80].

“The elements of the combinations of Claims 1, 2, 3, 4, 5, 6, 7, 8, 9, 12, 13, 14 and 15 of Patent No. 2,633,786 perform additional and different functions in combination than they perform out of the combination, to wit: they provide a hitch mounting for a ‘Ford-Ferguson’ type tractor with power lift draft links, and provide a construction wherein the weight of the two-way plow assembly is effective to assist in turning the plow carrier on the longitudinal beam of the frame.” [Find. of Fact 46, R. 80].

“The elements of the combinations of Claims 3, 8, 10 and 15 of Patent No. 2,659,284 perform additional and different functions in combination than they perform out of combination, to wit: they provide a direct mounting connection for a two-way plow

for support on the rear of a tractor, the support means on the plow being mounted at opposed ends of a cross member of the frame, thereby producing a close coupling connection to minimize rearward extension of the parts of the plow and thereby minimize 'bucking' or undesirable lifting of the front end of the tractor." [Find. of Fact 47, R. 81].

The criteria for determining the presence of invention, as set forth by Judge Learned Hand are:

"the length of time the art, though needing the invention, went without it; the number of those who sought to meet the need, and the period over which their efforts were spread: how many, if any, came upon it at about the same time, whether before or after: and—perhaps most important of all—the extent to which is superseded what had gone before. *Safety Car Heating & Lighting Co. v. General Electric Co.*, 2 Cir., 1946, 155 F. 2d 937, 939."

Those tests of invention were cited with approval in the Ninth Circuit case of *Pointer v. Six Wheel Corporation*, 177 F. 2d 153, 162 (1949). The same tests for invention were referred to in *Leishman v. General Motors Corp.*, 191 F. 2d 522, 531, 9th Cir. (1951).

In the decision of the District Court in the present Pursche case, as stated orally from the bench at the close of the trial, the trial Judge indicated that he was adopting these tests for invention:

"I have in mind the statement of this circuit in the Leishman case which was cited this morning, in 191 F. 2d, that the court takes into consideration four things." [R. 1292].

The Court continued:

“The first is the length of time that the art went though needing the invention and the length of time it went without it. Certainly the length of time that a rollover plow, a successful rollover plow which was operable and which could be easily operated and which would not only plow shallow and merely scrape the surface of the ground, such as a cultivator or a harrow, but would actually turn the soil, was needed and it has been needed in the art for a long time.

A second element is the number of those who sought to meet the need and the period over which their efforts were spread. The prior art patents here showed that people attempted in the American scene (and disregarding the foreign patents), that people were attempting to meet this need as long ago as 1871. Certainly not the Capon nor the Unterilp patents, which are crude, and in my judgment, neither of them would work—I think the Unterilp patent if it were built and put in the ground would break to pieces; I do not think it would hold together at all—so it could not have been a new and useful thing, and it did not anticipate the combination that is here.

I merely cite those to show how long other people had been at it.

The third element is how many others came upon the same idea and about the same time. Well, people were getting close to the idea when they got the Lindeman plow and when they got some of the Ferguson plows. But neither the Lindeman plow nor the Ferguson plow, in my judgment, anticipated the plow which Mr. Pursche invented here.

The fourth element, and described as the most important of all, is the extent to which it superseded what had gone before, I think the evidence is pretty plain, in this case that the basic and general methods which were devolved by Mr. Pursche here, whether they are infringed or not is another question, but the basic and general method has certainly superseded the prior art in plows."

With regard to the first and second elements in the above-noted test, the party Atlas set up some ninety-odd prior patents and prior publications to show anticipation of the Pursche inventions [R. 77] but the District Court held that

"This large number of patents and publications serves only to emphasize the importance of the inventions made by the party Harry A. Pursche and covered by the patents in suit." [Find. of Fact 34, R. 77].

As set forth in *Reynolds et al. v. Whitin Mach. Works*, 167 F. 2d 78 (C. C. A. 4 1948), at page 83

"Defendant has cited 21 patents as basis for its contention that complainants' invention is lacking in novelty; and this in itself is evidence of the weakness of the contention. Such a citation of so many prior patents almost always means either that none of them is in point and that the patentee has brought together for the purpose of his invention devices to be found in prior patents of different character, or that there have been prior attempts to solve the problem with which he was confronted which have not met with success (citing cases). Patents for useful inventions ought not be invalidated and held

for naught because of such excursions into the boneward of failures and abandoned experiments.”

The evidence that the two-way plows embodying the Pursche invention have superseded the prior art includes the fact that one of the world’s largest builders of agricultural machinery, International Harvester Company, took a license under the Pursche patents and abandoned its own efforts to develop a successful two-way rollover plow, and now markets a line of two-way plows for which it pays royalties to Pursche under the same patents involved in this litigation. At the time of the trial, Pursche had received in excess of \$35,000.00 in royalties from International Harvester Company. [Find. of Fact 53, 54, 55, 56. R. 82, 83]. While there is no evidence that the Capon plow [R. 1399] or the Unterilp plow [R. 1494] were ever constructed, the evidence does show that the Jumbo plow [R. 1540] shown in the Kaltoft patent [R. 1338] was abandoned and is no longer under production [R. 673], and that the Lindeman plow [R. 1636] likewise has become abandoned [R. 660].

The Trial Court also said:

“Taking each one of the plaintiff’s patents, I do not think there was any anticipation in any of the prior art which has been shown to this Court. Certainly in the prior art patents, and in the prior art, outside of the patents, all of the elements which were put together by the farmer, Mr. Pursche, to make a successful plow, that is a useful rollover plow—and in my judgment a new one—were known. But he put them together in a combination which was, in my judgment, new and useful.” [R. 1292].

The Pursche Patents Meet the Strict Standards of Invention Required by Ninth Circuit Decisions.

The Ninth Circuit cases of *Harry X. Bergman et al v. Aluminum Lock Shingle Corporation of America*, 251 F. 2d 801 (1957), *Kwikset Locks, Inc. et al. v. Hilgren*, 210 F. 2d 483 (1954), *Talon, Inc. v. Union Slide Fastener, Inc.*, 266 F. 2d 731, *Berkeley Pump Company v. Jacuzzi Bros. Inc.*, 214 F. 2d 785 (1954) and *Oriental Foods v. Chun King Sales*, 244 F. 2d 909 (1957) all held patents invalid on the basis of the stringent requirements set forth by the U. S. Supreme Court in *Great Atlantic and Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147 (1950). Consideration of the subject matter involved in each of these cases, however, shows that only simple and rudimentary improvements were involved and these were of the type that a skilled mechanic might very well have constructed. Indeed, the Turnham patent 2,242,408, invalidated by the Supreme Court in the Supermarket decision, related only to a three-sided open bottom pusher device for sliding merchandise along a counter extension. The harsh language of the decision must be read in the light of the utter simplicity of the subject matter. The Korter patent 2,631,552 involved in the *Bergman* case in the 9th Circuit stands on similar grounds; the only thing new is a drain slot in an aluminum shingle. Similarly, the *Hilgren* case in the 9th Circuit held the Hilgren patent 2,403,597 invalid but the only thing new was the addition of a dead latch to a reverse rocket-type lock, both being old in the prior art. In the *Talon* case, the Silverman patent 2,437,793 was held invalid because the method of attachment of the individual zipper elements, though claimed to be an improvement, did not differ materially

from the prior art, and at best represented only mechanical skill. Also, in the *Berkeley Pump* case the Carpenter patent 2,280,626 was held invalid because it covered only the addition of turbine type impellers to an old style pump. In the *Chun King* case the Paulucci patent 2,679,281 was held invalid as failing to meet the strict standard of the *Supermarket* case, the improvement constituting joining of two cans end-to-end by means of a tensioned tape wrapped around their adjacent ends. Summarizing, in each of these cases, the subject matter was simple and uncomplicated and only a trifling advance in the art was involved.

The Pursche patent '090 does not show a trifling advance in a very simple device. It shows a two-way plow having in combination a frame, a longitudinal beam fixed on the frame and extending to the rear, a plow carrier mounted to revolve on the longitudinal beam and provided with right-hand and left-hand plows, and a power developing hydraulic cylinder assembly on the frame acting through a power transmitting connection to revolve the plow carrier in either direction, thereby establishing a close coupled assembly in which the functions accomplished are more than the sum of the function of the separate elements [Find. of Fact 42, R. 79]. The elements perform an additional and different function in combination than they perform out of it: they provide a close coupling relationship between the frame, plow carrier and hydraulic cylinder assembly which enables the operator to turn the carrier independently of forward motion and independently of the raising and lowering action and provides quick entry and exit of the plow in relation to the land, with the result that the space required at the headlands for turn around is sub-

stantially decreased with relation to prior art devices. [Find. of Fact 44, R. 79]. Each of the other Pursche patents in suit is directed to combinations in which the elements perform additional and different functions in combination than they perform out of combination [Find. of Fact 42, 45, 46 and 47].

The Pursche patents in suit relate to valid combinations of the type sustained in the Ninth Circuit cases *Stearns v. Tinker & Razor*, 9th Cir. 220 F. 2d 49 (1955) Cert. denied 350 U. S. 830; *Coleman Company, Inc. v. Holly Manufacturing Company*, 9th Cir. 233 F. 2d 71 (1956) Cert. denied, 352 U. S. 952; *Ry-Lock Company, Ltd. v. Sears Roebuck & Co.*, 9th Cir. 227 F. 2d 615 (1955); *Pointer v. Six Wheel Corp.*, 9th Cir. 177 F. 2d 153 (1944); *Speed Corp. v. Webster*, 9th Cir. 262 F. 2d 482 (1959).

The Stearns invention filled a long felt need in its field and it was specifically pointed out that the elements of the patent “do functionally operate differently in the combination than they did in their old surroundings.” In the *Coleman* case the “economizer” as integrated into the device caused all of the elements in combination “to cooperate in a new way to produce a new, useful and unexpected result in the room heating art.” In the *Six Wheel* case the addition of a universal joint between a rocker arm and a second axle assembly was held to produce a new combination achieving a “particularly unitary result,—a new function.” In the *Ry-Lock* case the patent on a tensioning and locking device for a frameless window screen was held valid and infringed. The Court said

“In our view there is invention here, for the whole of what Ry-Lock has produced exceeds the sum of its parts, and it measures up to the standards of in-

vention which this Court has approved in the Winslow case.” (*Winslow Engineering Company v. Smith*, 9th Cir. 223 F. 2d 438).

In the *Speed Corporation* case patent 2,253,990 was held valid and infringed. The patent covered a handle for engaging various tools such as files, screw drivers, etc. The single claim of the patent was directed to a combination of parts having the unique property of adjusting themselves to accomodate tool shanks of various contours.

A study of the Ninth Circuit decisions on patents claiming combinations of old elements to produce new results shows that as the facts vary the application of the law likewise varies. In the present case, the facts demonstrated to the District Court showed that it remained for the farmer Pursche not only to discover and recognize the solution to the problem of providing a heavy duty two-way plow, but also to teach the present day farm implement manufacturers the solution to the problem, among such companies being the oldest manufacturers of farm implements in the United States.

The “last step” doctrine also applies to the Pursche patents in suit. As set forth in the Barbed Wire patent case, 143 U. S. 275 at 282,

“Under such circumstances courts have not been reluctant to sustain a patent to the man who has taken the final step which has turned a failure into a success. In the law of patents it is the last step that wins. It may be strange that, considering the important results obtained by Kelly in his patent, it did not occur to him to substitute a coiled wire in place of the diamond shape prong, but evidently it did not; and to the man to whom it did ought not to

be denied the quality of inventor. There are many instances in the reported decisions of this court where a monopoly has been sustained in favor of the last of a series of inventors, all of whom were groping to attain a certain result, which only the last one of the number seemed able to grasp.”

As set forth in the *Sbicca-Del Mac v. Milius Shoe Co.*, 145 F. 2d 389 at 394,

“Under the circumstances present in this case the rule has often proved helpful and has frequently been applied that ‘the man who has taken the final step which has turned a failure into success’ is entitled to a patent; that ‘it is the last step that wins’; and that where a series of inventors are groping to attain a certain result, the last one who grasps the idea which renders the article or method useful and effective is entitled to a patent—that his thought constitutes invention.”

As set forth in *Lincoln Stores, Inc. v. Nashua Mfg. Co.*, 157 F. 2d 154 at 163,

“Retrospection is often deceptive and cannot be accorded recognition in the law pertaining to patents. *Diamond Rubber Co. v. Consolidated Rubber Tire Co.*, 1911, 220 U. S. 428, 435, 31 S. Ct. 444, 55 L. Ed. 527. At least Amory provided the final step that proved the difference between success and failure. This is a factor which has been accorded considerable recognition in the courts. *The Barbed Wire Patent 1892*, 143 U. S. 275, 283, 12 S. Ct. 443, 36 L. Ed. 154; *Consolidated Safety-Valve Co. v. Crosby Steam Gauge & Valve Co.*, 1885, 113 U. S. 157, 179, 5 S. Ct. 513, 28 L. Ed. 939.”

As set forth in the *Montgomery Ward & Co. v. Clair*, 123 F. 2d 878 at 881, Circuit Court of Appeals, 8th Cir.:

“The law is that whoever finally perfects and improves a device and renders it capable of practical, useful and effective operation is entitled to a patent although others had the idea and made experiments toward putting it into practice.”

Detailed Point-by-Point Answers to Each of the Atlas “Forty-four Points” of Alleged Error.

At the outset it must be noted that Atlas admits infringement of the claims of the patents in suit in accordance with the following schedule:

| | |
|---------------------|----------------------------------|
| Patent '090—Ex. #18 | Claims 2-27 inclusive |
| Ex. #22 | Claims 3, 10, 12, 18, 25, 26, 27 |
| Patent '089—Ex. #18 | Claims 12, 13, 14, 15, 16 |
| Patent '091—Ex. #18 | Claims 6, 7, 8, 9, 14, 15, 22 |
| Patent '284—Ex. #22 | Claims 3, 8, 10, 15 |
| Patent '786—Ex. #22 | Claims 5, 6, 12 |

Not one of the Atlas forty-four points even alleges non-infringement of the claims in the above table. The only issue of infringement relates to claims 1-4, 7-9, 13-15 of Patent '786. A total of 45 claims are thus admitted to be infringed.

The assertion of Atlas of invalidity of all of the claims are based on many separate defenses. Among these are aggregation, lack of invention, double patenting, failure to distinctly claim the invention, overclaiming and late claiming. Each of these defenses is discussed under the particular one of the Atlas forty-four points where it is raised. The same is true as to the discussion of the count for Unfair Competition, discussed in the Atlas Twenty-Ninth to Thirty-Ninth points.

Atlas First Point: “The District Court erred in failing to hold that claims 2 to 5 inclusive, 10, 12, 14, 17, 18, 19 and 25 to 27 inclusive of the '090 patent are incomplete, do not define an operative structure, and are invalid under 35 U. S. C. Section 112.”

All of the claims in issue call for “means on the frame” or “power means on the frame” to turn the carrier. There is no requirement that power means to be defined in each claim as a hydraulic cylinder assembly located in a particular place on the frame. Various aspects of the invention are set forth in Claims 1-5, 10, 14, 17, 18, 19, 25 and 26 and there is no basis whatever for the Atlas contention that each claim must include the particular words: “power developing hydraulic cylinder assembly on the frame acting through a power transmitting connection.” None of the claims can be read on the prior art, and each of them defines an inventive structure which was demonstrated in actual field operations to the Trial Judge.

The Ninth Circuit case of *Winslow Engineering Co. v. Smith*, 223 F. 2d 438 is not in point. In that case it was held that the invention resided in a “growth factor” but that none of the claims defined structure which produced it. As distinguished from that situation, “power means on the frame for turning the carrier” is recited in each of the claims in issue.

Atlas Second Point: “Claims specifying less parts than are required for an operative machine are incomplete and therefore invalid.”

Atlas relies on *Goodman v. Super Mold Corporation of California*, 103 F. 2d 474 for the proposition that “claims specifying less parts than are required for an

operative machine are incomplete and therefore are invalid." The patent disclosed a tire mold having two rings one on each side of the tire. The claim calling for both rings was held valid and infringed, but a similar claim requiring only one ring was held invalid because it was "incomplete."

The proposition of law stated in the "Second Point" is erroneous. The United States Supreme Court has said,

"The statutes permit and it is the settled practice of the Patent Office many times sustained by this Court, to allow claims to a combination and also its subcombinations." *Special Equipment Co. v. Coe*, 324 U. S. 370, 377.

Whether the old doctrine applying to the particular facts of *Goodman v. Super Mold Corp. of California*, 103 F. 2d 475 is still good law need not be decided, since the later United States Supreme Court case is clearly controlling.

The *Goodman v. Super Mold* case has not been followed nor cited with approval in any subsequent reported case with relation to the portion quoted.

None of the cases cited in the Atlas Brief support the language of the "Second Point." *Schriber-Schroth Co. v. Cleveland Trust Co., et. al*, 305 U. S. 47, held that the web of a piston originally described as "extremely rigid" could not later by amendment be described as "laterally flexible." In *General Electric v. Wabash Co.*, 304 U. S. 364, a description of an incandescent filament as being "made up mainly of a number of comparatively large grains of such size and contour as to prevent substantial sagging," was held an inadequate definition. In *United Carbon Co. v. Binney Co.*, 317 U. S. 228, claims

were held invalid for lack of distinctiveness. The claims required “substantially pure carbon black in the form of commercial uniform, comparatively small, rounded, smooth aggregates having a spongy or porous interior” or “as an article of manufacture, a pellet of approximately 1/16” diameter and formed of a porous mass of substantially pure carbon black.” *Graver Mfg. Co. v. Linde Co.*, 336 U. S. 271, held invalid a group of claims stating that the sole conducting medium for passage of electric current was in the molten welding composition, thereby eliminating any arc. This definition was held to be faulty, because the flux hides from view what actually occurs and it is impossible to say with certainty that there is no arc.

It is apparent that none of these cases is authority for the proposition stated.

It is submitted that the correct rule is set forth in *Ellis on Patent Claims*, 1949 §141:

“ELEMENTS INCLUDED IN A CLAIM NEED NOT EXCEED THOSE REQUIRED TO DEFINE THE PARTICULAR INVENTION THAT CLAIM IS DRAWN TO COVER.

* * * * *

“The same rule applies to combination and sub-combination claims. Every claim need not include all novel elements in the machine. All that is required is that each claim covers a patentable invention. A complete machine may embody numerous inventions, the number of which depends on how many combinations and permutations of elements, each patentable *per se*, are included in the entire machine. A claim, therefore, need not include elements not essential to the definition of the particular invention that claim is drawn to cover.” (Citing *Brammer v. Schroeder*, 106 Fed. 918 (C. C. A. 8).

Atlas Third Point: “Claims 1 to 5 inclusive, 10, 14, 17 to 19 inclusive, 25 and 26 of the '090 patent must be held invalid by this Court because there is no finding of the District Court that the assembly of elements recited in these claims performed an additional and different function in combination, than they perform out of it.”

The statement of the “Third Point” is factually inaccurate, and erroneous. Findings 43 and 44 [R. 79] include all of these claims and each claim requires “a power developing hydraulic cylinder assembly on the frame” or an equivalent statement. Thus:

Claims 1, 2, 3:

“means on the frame adapted to turn the carrier.”

Claim 4:

“means on the frame for rotating the carrier.”

Claim 5:

“power means on the frame adapted to turn the carrier.”

Claim 10:

“power means mounted on the cross member operatively connected to the carrier to bring either plow into operative position.”

Claim 14:

“means on the frame independent of movement of the plow assembly relative to the ground for turning the carrier relative to the beam.”

Claim 17:

“means for turning the carrier to either of two operative positions relative to the frame.”

Claim 18:

“means on the frame for turning the carrier to either of two operative positions relative to the the frame.”

Claims 19, 25, 26:

“power means on the frame for turning the carrier.”

The “Third Point” is thus factually erroneous and merits no further consideration.

Atlas Fourth Point: “The District Court erred in making Findings 43 and 44 and erred in finding that the assembly of elements specified in these two findings established a close coupled assembly performing any new or additional results in combination.”

There are not four but thirteen findings relating to the validity of the '090 patent. They are Nos. 35, 36, 37, 38, 43, 44, 50, 51, 52, 53, 54, 55, 56.

Counsel for Atlas refers to the findings of the learned Trial Judge as “hogwash.” Perhaps that flagrant impropriety was used to obscure the fact that the cases cited do not support the argument. It is well settled that “a patentee who is the first to make an invention is entitled to his claim for all uses and advantages which belong to it.” *Stow v. Chicago*, 104 U. S. 547 (1881). As stated in *Kellogg Switchboard and Supply Co. v. Dean Electric Co., et al.*, C. C. A. 6 (1910), 182 F. 991 at 998. “It is objected that the advantage of avoiding side tones is not mentioned in the specifications. This is true. But this omission was not fatal if the advantage was necessarily achieved through the invention.” (Citing cases.)

In *National Hollow Brake Beam Co. et al. v. Interchangeable Brake Beam Co.*, 106 Fed. 693, 709 the Court said

“When (an inventor) has plainly described and claimed his machine or combination, and has secured a patent for it, he has the right to every use to which his device can be applied, and to every way in which it can be utilized to perform its function, *whether or not he was aware* of all these uses or methods of use when he claimed and secured his monopoly . . .” (Emphasis added.)

To the same effect are the Ninth Circuit cases *Bingham Pump Co., Inc. v. Edwards*, (C. A. 9), 118 F. 2d 338, 340, *Lorraine Corporation v. Union Tank & Pipe Co.* (D. C. S. D., Calif., Central Division), 48 F. 2d 847, 848, Affirmed 48 F. 2d 848, and *Talon, Inc. v. Union Slide Fastener, Inc.*, 266 F. 2d 731, 734 (C. A. 9).

Neither the *Lincoln Engineering* case nor the *Kursheedt* case relied on in support of the “Fourth Point” were decided on the basis of the portions quoted by Atlas. The *Lincoln Engineering* case held that an improvement of one part of an old combination gave no right to claim that improvement in combination with other old parts which perform no new function in the combination. The *Kursheedt* case held that the patent was only of limited scope, and as thus interpreted it was not infringed.

The compactness feature or close-coupled feature discussed at some length in the Atlas brief is not difficult to understand nor hard to find. Figure 11 of the '090 patent shows that the forward plow point lies very close to the cross member 21 of the frame 20 and very close to the hydraulic cylinder 45 mounted on the cross mem-

ber 21. The forward point of the front plow share is placed very closely behind the rear cross member 21 of the frame without interfering with the power means on the frame for turning the carrier 15. This same advantage is shown in the construction of the later filed '089 patent wherein the forward point of the plow share 18 as shown in Figure 2 projects forward of the frame latch 78. This same close coupled connection is shown in Figure 1 of the '786 patent and in Figure 1 of the '284 patent. The construction making this close coupled feature possible is set forth in the claims of the '090 patent, and is present in the accused devices and is not to be found in any of the prior art devices. The prior art devices of Lindeman, Prigden, or Dexheimer do not employ a hydraulic cylinder on the rear cross member of the frame for turning the plow carrier, but all of the accused devices do.

Atlas Fifth Point: "The District Court erred in making Findings 43 and 44 and was manifestly in error in finding any new coaction or new function as the result of mounting a hydraulic cylinder assembly on the plow frame."

In the Capon patent [R. 1399] no means is provided for raising the plows from the ground prior to rotating the carrier. Moreover, the carrier is not rotated by any power means on the frame, or in the absence of forward movement of the entire structure. Forward motion of the ground wheels 25 or 26 is supposed to drive the gears 18 and 19 through sprockets 37 and 32. In the construction of its plows, Atlas has chosen to copy not Capon but Pursche.

Not one of the other eight prior art patents listed on page 73 of the Atlas brief uses a power means on the

frame to turn the carrier in the manner set forth in the claims of the '090 patent. Kaltoft [R. 1338] shows a power cylinder acting through cables 53 and 57 for alternate raising and lowering of the plows 39 and the plows 36 in their individual frames about the horizontal pivots 34, 35. There is no rotating carrier. The same comments apply to the abandoned Jumbo plow [R. 673, 1540]. Briscoe [R. 1382] shows hydraulic cylinders 9 and 19 but neither acts to turn a plow carrier. DeRocher Patent No. 2,113,556 shows a disk plow but the power cylinder 29 does not serve to rotate any plow carrier. Chapman [R. 1303] has a "lifting jack" which is manually operated but it does not turn the plow carrier. Acton [R. 1431] shows power cylinders on a disk harrow for raising and lowering ground wheels. Conley [R. 1334] shows a power cylinder mounted on a plow for raising and lowering ground wheels, but not for rotating any plow carrier. Bunting [R. 1421] has a power cylinder for raising and lowering a plow assembly but not for turning any plow carrier. Atlas has not followed the teachings of any one of these prior art patents but has copied the Pursche construction as set forth in the claims of the '090 patent.

The proposed combinations of prior art patents mentioned by the Atlas expert witness, Fishleigh, are based solely on hindsight. Moreover, when asked for his "best reference" for anticipating the '090 patent he replied that it was Capon *et al.* 2,426,548 [R. 1399] taken with the German patent to Unterilp 49,222 [R. 1494]:

"Probably, as I say, for the reasons stated I would think Capon was the best" [R. 1042].

"Moreover, when combined or taken into consideration with the Unterilp tail wheel, the Capon struc-

ture with that tail wheel includes all of the mechanical elements that are included in any of the claims.” [R. 1041.]

But the Trial Court after hearing all of the testimony and after considering a small model [Ex. HH] of the Capon patent, and both small and full-size scale models of the German patent to Unterilp [Exs. I-I and J-J] found that neither of these patents anticipate any of the claims of the patents in suit. [Finds. of Fact 35, 36, R. 77].

The Atlas brief, page 79, criticizes Finding 44 because “it states that the carrier can be turned independently of raising and lowering action.” It is clear from the full context of the Finding that it distinguishes over Lindeman Patent No. 2,543,786 [R. 1438] which can only turn the plow carrier as a function of raising it, just as the Finding distinguishes from the Capon disclosure [R. 1399], by stating that the carrier may be turned independently of forward motion of the plow assembly. Capon discloses no means of lifting the carrier and the only means of turning the carrier is by forward motion of one of the ground wheels.

Findings 43 and 44 are not erroneous and should not be set aside.

Atlas Sixth Point: “The District Court erred in failing to hold claims 1 to 5 inclusive, 10, 12, 14, 17 to 19 inclusive, and 25 to 27 inclusive of the '090 patent invalid on the grounds that they are anticipated by the prior art, lack invention over the prior art, and are aggregational.”

Each of the arguments presented in connection with this Sixth Point is based on a proposed combination of

the disclosure of one or more prior art patents with the disclosure of the German patent to Unterilp No. 49,222 [R. 1491]. But the Trial Judge held after watching a demonstration of a full sized model of the device shown in that German patent that

“The device was crude and would not work”
[Find. 37, R. 78].

and further specifically held that the disclosure of that German patent

“does not anticipate any of the claims of the patents in suit” [R. 77].

Furthermore, nothing set forth under the Sixth Point or anywhere else in the Atlas brief shows that the Trial Judge was “clearly erroneous” in regard to these findings.

Moreover, there is absolutely no teaching in any of the ninety odd prior patents and prior publications set up by Atlas that would lead a man skilled in the plow art to attempt to apply the Unterilp tail wheel to the carrier of any two-way plow.

Atlas Seventh Point: “The District Court erred in failing to hold claims 5, 19, 25 and 26 of the '090 patent invalid on the grounds of anticipation, lack of invention, and aggregation.”

The Atlas B-5 plow shown on Exhibit 22 [R. 1668] squarely infringes Claims 25 and 26 of the '090 patent, in spite of the contrary statement contained on page 90 of the Atlas brief. Both right-hand and left-hand plows in the forward gang of the B-5 plow are clearly shown to be carried on supports mounted forward of the thrust collar.

The Capon patent 2,426,548 [R. 1399] was cited by the Patent Office in the file of the '090 patent but was not specifically applied against the claim which issued as Claim 5 of the patent. The reason is perfectly apparent: the Capon disclosure does not include any "power means on the frame for turning the carrier to either of two operative positions." Only the forward motion of the ground wheels is available to turn the gears 18 and 19 for turning the plow carrier. The successful operation of such a device is doubtful in the extreme because no means are provided for raising the carrier before turning it. It is intended that the plow shares be rotated out of the ground by turning the carrier as one of the ground wheels turn. Atlas did not copy the Capon plow. It copied the Pursche plow, first under license and later without any license.

The attempt to discredit claims 5, 19, 25 and 26 on grounds that they relate only to a thrust collar is a weak effort indeed. Admittedly each of the elements of the claimed combination is old.

Atlas Eighth Point: "The District Court erred in failing to hold claims 10 and 12 of the '090 patent invalid over the prior art on the grounds of lack of invention and of aggregation."

The validity of Claims 10 and 12 of the '090 patent is first attacked on the technical grounds that:

1. The tongue is not stated to be horizontally swingable.
2. No means is set forth in the claims for securing the forward end of the tongue against vertical movement.

Neither of these contentions has any merit. Whether the tongue can shift horizontally has nothing to do with the subject matter of these claims. Furthermore, in the normal use of Atlas plows and Pursche plows in which a tongue is provided for connection to the tractor, the tractor prevents upward movement of the forward end of the tongue. When no tongue is provided and the plow assembly is carried directly on the tractor both Atlas and Pursche plows provide lift means connected with the cross member for lifting the entire length of the beam member.

A second attack on the validity of these claims is based on the disclosure of the Capon patent 2,426,548 [R. 1399, 1402]. The Atlas expert witness Fishleigh tried desperately to find in this Capon patent something to support an argument that the longitudinal beam and the carrier could be lifted up away from the ground, in spite of the fact that this is contrary to the method of operation described in the Capon specification. Pursche pointed out that the small unnumbered clip near the lead line from numeral 124 in Figure 8 of the Capon patent is only for the purpose of holding up the tongue, and performs the same function as the pivoted arms "C" in the Prechtel patent 372,235 [R. 1690]. Although the model of the Capon patent was demonstrated to the Trial Judge he held that

"The disclosure of the Capon patent No. 2,426, 548 [Ex. A-45] does not anticipate any of the claims of the patents in suit" [Find. 35, R. 77].

The third assault on the validity of Claims 10 and 12 is based on the disclosure of Neufang [R. 1324], Lindeman [R. 1438], Briscoe [R. 1382], Prigden [R. 1351] Kaltoft [R. 1338], the abandoned Jumbo plow [R. 1512],

and Dexheimer [R. 1463] but not one of these disclosures shows power means or a hydraulic power cylinder carried on the cross member for turning the carrier to bring either plow into operative position. Furthermore, Dexheimer [R. 1463] is the only one of these references which has a stationary beam member extending longitudinally and lift means that connect with a cross member for lifting the entire length of the beam member. However, Dexheimer does not use power for swinging his 90 degree plow shares into and out of plowing position and there is no suggestion in the prior art of mounting a power cylinder assembly on the same cross member and is used to lift the beam for the purpose of turning the plow carrier.

Atlas Ninth Point: “The District Court erred in failing to hold claim 18 of the '090 patent invalid on the ground of lack of invention over the prior art, and aggregation.”

It is argued in the Atlas brief that Claim 18 of the '090 patent reads on several prior art references. Such is not the case. Doane, Matisse and Unterilp do not have symmetrically positioned plows as required, and it is impossible to determine whether Neufang's plows are symmetrically positioned or not, since there is no view in the drawings showing this feature. The Capon patent [R. 1399] does not meet the last element of the claim which requires interengaging means on the carrier and frame. The set screw 63 strikes the laterally shiftable bar 64 for controlling action of the clutches 33 and 38, but it does not contact any part of the frame.

.Claim 18 of the '090 patent is also challenged on grounds that the required symmetrical spacing of the plow bodies is not supported by the disclosure. References to

Figure 6 of the drawings, however, shows that the plow points where the plows enter the ground are symmetrically spaced on each side of the longitudinal beam.

Accordingly the arguments challenging validity of Claim 18 are not well founded.

Atlas Tenth Point: “The District Court erred in failing to hold claim 27 of the '090 patent invalid on the ground of lack of invention, aggregation, incompleteness, failing to read on the disclosure of the application as originally filed, and being broader than the alleged invention.”

The validity of Claim 27 of the '090 patent is attacked on five different grounds. Considering these in order:

Lack of Invention. Although the prior art patents to Capon, Neufang, Doane, Prigden, Dexheimer and Chapman are listed as performing “the identical function,” not one of these patents shows a hydraulic power cylinder assembly mounted on the frame and acting to turn the plow carrier in either direction.

Aggregation. There is nothing whatever aggregative about this claim since each of the elements defined coact with the other elements to produce a unitary result. The close coupled relationship resulting from this combination was specifically found to be inventive in Findings 43 and 44.

Incompleteness. All of the elements required for a complete operative assembly are set forth in this claim. “The statutes permit and it is the settled practice of the Patent Office many times sustained by this Court, to allow claims to a combination and also to a subcombination.” *Special Equipment Co. v. Coe*, 324 U. S. 370, 377.

Failing to Read on the Disclosure of the Application as Originally Filed. In the specification as originally filed the means for rotating the carrier were described in the following language:

“Means are provided on the frame 12 for rotating the carrier 15 from the position shown in Figure 1 to the position shown in Figure 11, and as is shown in the drawing, this means includes a sheave 39 fixed to the forward end of the pipe 16 on the carrier 15 by any suitable means, such as the set screw 40. * * *.”

Applicant thus recognized that the flexible cable arrangement was only one means for turning the carrier. Only a preferred form of the invention need be illustrated in the drawings, whereas the claims define the scope of the invention. Of the thirteen original claims filed in the application, all but numbers 5, 12, and 13, later cancelled from the case, required means or power means on the frame for turning the carrier, but not one of them recited a flexible cable. When Patent Claim 27 (Application Claim 32) was added by amendment to the application it was accompanied by the following statement:

“This claim relates to that feature of the invention wherein a movable power element of a hydraulic cylinder assembly acting in a plane normal to the longitudinal support beam turns a torque receiving element fixed on the forward end of the carrier by means of an intermediate element. The counterparts of the element set forth in this claim are clearly disclosed in the drawings of this application wherein the ‘torque-receiving element’ is the cable drum 39

and the 'intermediate element' is the cable 41. None of the references appears to be pertinent to this construction."

No new matter was involved. The Patent Office entered the claim without objection.

Page 112 of the Atlas brief cites *Halliburton v. Walker*, 329 U. S. 1 and *Schriber-Schroth Co. v. Cleveland Trust Co.*, 305 U. S. 47, as authority for the allegation that Claim 27 is either invalid or it must be construed as being limited to the form disclosed in the application. No such conclusion is warranted from either of these cases. The prior art does not show the combination which includes a hydraulic power cylinder assembly mounted on the frame for turning the carrier in either direction. The fact that Claim 27 defines this element of the combination in greater detail does not make the combination invalid nor bring the claim within any rule of invalidity within the *Halliburton* or *Schriber-Schroth* cases.

The late claiming doctrine of the *Muncie Gear* case and the *Western Lithograph* case cited in the Atlas brief is not applicable to the facts here. Broader claims to the same subject matter were presented in the original application of the '090 patent. Thus, original application claim 11 (cancelled before issue) read as follows:

"In a two-way plow assembly, the combination of a mobile frame, a carrier extending rearwardly from the frame and provided with a right-hand plow and a left-hand plow, means on the frame for turning the carrier about the longitudinal axis to bring either plow into operative position, and interengaging means on the carrier and frame adapted to limit the extent of turning movement of the carrier relative to the frame."

Atlas Eleventh Point: “The District Court erred in failing to hold claim 27 of the '090 patent invalid on the ground of overclaiming.”

The alleged novelty in Claim 27 is *not* within the details of element 5 of the claim, contrary to the statement in the Atlas brief. The novelty in this claim resides in the combination of parts acting as defined to produce the results set forth in Findings 43 and 44. The cases of *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U. S. 545, 549; *Bergman v. Aluminum Lock Shingle Corporation of America*, 251 F. 2d 801, 808; *Great Atlantic & Pacific Tea Co. v. Supermarket Corp.*, 340 U. S. 147, 50, and *Willamette-Hyster Co. v. Pacific Car & Foundry Co.*, 122 F. 2d 492, all relate to the situation where the applicant had merely improved one element of a prior art combination and where no change resulted in the combination as a result of this improvement. Not one of the ninety-odd prior art patents and publications cited by Atlas shows a two-way plow having a hydraulic cylinder assembly mounted on the rear cross beam of the frame for turning the plow carrier. The broad combination is new. Claim 27 sets forth this new combination and specifically spells out certain details of the connection between the hydraulic cylinder and the plow carrier. This is clearly permitted under the decisions cited.

Atlas Twelfth Point: “The District Court erred in failing to hold patent '786 invalid on the ground of lack of invention, aggregation, double patenting and that the claims are vague, indefinite and insufficient and do not comply with 35 U. S. C. 112.”

Although several grounds of invalidity of the '786 patent are contained in the statement of the “Twelfth

Point”, only one of those grounds—Aggregation—is mentioned in the supporting argument. The assembly of plow elements in the '786 patent disclosure is *not* identical to the '090 patent. Quite obviously, the '786 patent shows no supporting wheels on the frame or power cylinders to raise and lower the frame by swinging the wheels or any swinging tongue or mechanism for swinging the tongue, and instead the '786 patent shows a frame particularly constructed for pivotal support on the draft links of a tractor. It is true that a plow of the '786 patent has certain features in common with the other Pursche plows as set forth in Finding 12 [R. 72] but the claims of the '786 patent are not directed to any combination disclosed in any other Pursche patent. Accordingly, the charge of Aggregation is groundless. It is, of course, immaterial how Mr. Pursche learned of the best place to tap into the hydraulic system of the tractor:

“Patentability shall not be negatived by the manner in which the invention was made.” 35 U. S. C. §103.

The claims are directed to a combination of elements producing a new result.

The allegation of non-infringement of Claims 1-4, 7-9, and 13-15 is treated under the “Thirteenth Point”, below.

Atlas Thirteenth Point: “The District Court erred in failing to hold that claims 1 to 4, 7 to 9, and 13 to 15 of the '786 patent are not infringed by the B-5 plow.”

Claims 1-4, 7-9, 13-15 of the '786 patent relate to pressurizing of the tractor hydraulic system by the weight of the two-way plow assembly whereby such weight assists in turning the carrier on the frame. Contrary to

statements in the Atlas brief, the claims are not limited to a Ford-Ferguson tractor. The claims relate to a particular two-way plow construction for use with the type of tractor having draft links liftable under hydraulic power, and wherein the hydraulic pressure for operating the carrier roll-over cylinder is obtained from the tractor hydraulic lift system. The Atlas brief does not deny that the B-5 plow of Exhibit 22 when mounted on an Oliver tractor with draft links liftable under hydraulic power [R. 1668] constitutes an infringement of these claims. Instead an attempt is made to quote the testimony of Pursche to show some different manner of operation. A complete reading of the Pursche testimony [R. 272] shows that there is no support for such argument.

The hydraulic hose connections to opposite ends of the roll-over cylinder are shown in Section A-A of the drawing B-5 contained in the Pre-trial stipulation Exhibit 7, and the same hydraulic hoses are shown in the photographs of Exhibits 12, 16 and 82. The trial Judge witnessed the field demonstration of the Atlas B-5 plow of Exhibits 22, UU-1, UU-2, UU-3, UU-4 and found that it infringed the claims of the '786 patent. His ruling has not been shown to be "clearly erroneous".

Atlas Fourteenth Point: "The District Court erred in failing to hold the claims of the '786 patent invalid for failure to meet the requirements of 35 U. S. C. 112."

Claim 4 of the '786 patent is charged by Atlas to be "vague, indefinite and functional". The introductory clause recited the environment and reads as follows:

"4. In a two-way plow assembly adapted for operation with a tractor provided with a pair of draft

links and a control link, a tractor also having a hydraulic system controlled by the control link for lifting the draft links upwardly, the improvement comprising:”

This background or environment is stated in general terms as it should be. *Refrigeration Engineering, Inc. v. York Corporation*, 168 F. 2d 896, 901, Ninth Circuit (1948).

The criticism of the requirement “hydraulic means for turning the carrier” on the grounds that the hydraulic cylinder does not act directly on the carrier but through the intermediate member, the cable, is not a valid criticism. Part of the “means” is hydraulic and that is sufficient.

The criticism of the last element of the claim is likewise unwarranted. The first two words of the element “and means” are not to be ignored. The claim recites sufficient structure to support the functional statement at the end, and this is all that is required. 35 U. S. C. §112. The contention made by Atlas under the “Fourteenth Point” would have merit only if the last element of the claim read as follows:

“and means whereby pressure imposed on the hydraulic system by weight of the plow assembly and ground wheel in elevated position acts to energize the hydraulic means of the plow assembly.”

When the structure is supplied so that the “means” includes “a conduit connecting the hydraulic system on said tractor with the latter said hydraulic means” the arguments simply do not apply.

Atlas Fifteenth Point: "The District Court erred in failing to hold that the claims of the '786 patent are invalid over the plow of the '090 patent."

Atlas argues that Claims 1-4, 7-9 and 13-15 of '786 patent are invalid because the patent was filed more than year after the demonstration by Pursche of the plow of the '090 patent, but in fact not one of these claims can be read upon the disclosure of the '090 patent or upon the '090 type plow. The preamble or environment relating to the draft links and control links on the tractor are of course, lacking. Moreover, the frame of the '090 plow was not pivotally connected to the draft links and control link and adapted to be raised and lowered thereby. The '090 plow certainly did not include

"means including a conduit connecting a hydraulic system on said tractor with the latter said hydraulic means whereby pressure imposed on the hydraulic system by weight of the plow assembly and ground wheels in elevated position acts to energize the hydraulic means of the plow assembly."

Certainly there is nothing but hindsight to guide a skilled mechanic to change the shape of the frame of the '090 plow to correspond to Ferguson or Lindeman or Dexheimer in order to mount such a frame on the tractor. None of the prior art patents mentioned has hydraulic means for turning the carrier on the frame to bring either plow into operative position.

Whatever Bunting and Brimhall did with the hydraulic connections, it is clear that they did not use the hydraulic power supplied by the tractor hydraulic system to roll a plow carrier of a two-way plow.

Atlas Sixteenth Point: “The District Court erred in failing to hold that the claims of the '786 patent are invalid in view of Dexheimer, Ex. A-60, taken in connection with Kaltoft, Ex. A-54, or the Jumbo Plow, Exs. AD-1 to 3 and AU-1 to AU-8.”

The Kaltoft patent [R. 1338] and the abandoned Jumbo plow [R. 1512, R. 1540] both show all of the right-hand plows mounted on one lift frame and all of the left-hand plows mounted on another lift frame. Both lift frames pivot about an axis extending transversely of the plow. A hydraulic power cylinder operates through cables to lift one or the other of the frames. There is no carrier, no longitudinal beam and nothing to roll the carrier. Atlas suggests that this disclosure be combined with that of Dexheimer [R. 1463] to anticipate the claims 1-4, 7-9 and 13-15 of the '786 patent. There is no suggestion anywhere in the prior art for making such substitution and reconstruction of parts and this amounts only to a flagrant example of hindsight.

Atlas Seventeenth Point: “The District Court erred in failing to hold claims 5, 6 and 12 of the '786 patent invalid as lacking invention over the prior art, and as aggregational.”

It is true that Claims 5, 6 and 12 of the '786 patent do not require any connection to the hydraulic system of the tractor in order that the weight of the plow be effective to assist in turning the plow carrier. However, these claims do *not* read upon the disclosure of the '090 patent or upon the '090 type plow. Considering Claim 5, for example, neither the '090 patent nor the '090 plow is “adapted for use with a tractor having draft links liftable under power and having an auxiliary link”. Moreover neither has “an upstanding post fixed on the

frame”. Also, neither shows “pivot means for connecting the draft links to the ends of the cross bar and for connecting the post to the auxiliary link”. Contrary to the statement in the Atlas brief it appears unlikely in the extreme that a “skilled mechanic could take the plow of Lindeman or Dexheimer or Pridgen and mount on it the rollover plow arrangement disclosed in the '090 patent.” This proposed reconstruction is certainly based only on hindsight.

The Atlas brief states:

“Lindeman is probably superior to '786 structure since it eliminates one of the hydraulic cylinders
* * *”.

It should be noted, however, that Atlas chose to copy not Lindeman but Pursche.

Atlas Eighteenth Point: “The District Court erred in failing to hold the '786 patent invalid and void on the ground of double patenting.”

It is true that Claims 1, 3, 10, 12, 18 and 25 to 27 of the '090 patent read on the disclosure of the '786 patent. It is noted that Atlas in its brief admits that these same claims read on the Atlas B-5 plow of Exhibit 22. But none of the claims of the '786 patent read on the '090 patent. The '090 patent does not show “a two-way plow assembly adapted for use with a tractor having draft links liftable under power” and it does not show “pivot means for connecting the draft links to the ends of the cross bar”. The following far fetched argument and strained interpretation appears on page 135 of the Atlas brief:

“In the '090 patent, the cross bar 21 is connected to the tractor through the other members of the

frame and the tongue and the short link 88 at the forward end thereof as shown in Figure 8. The ring 91 or the horizontal pin 89 may be considered as a pivot means for connecting the plow to the tractor. Since the tongue is connected to the frame and since the side members of the frame are connected to the cross beam, there is a pivot means which connects a draft link to the ends of the cross bar.”

The argument quoted is ridiculous and clearly fails to meet the claim requirement:

“pivot means for connecting the draft links to the ends of the cross bar”

as that requirement is to be interpreted by the drawings and specification of the '786 patent.

All of the cases cited under the “Eighteenth Point” and relating to double patenting are clearly not in point because there is no claim in the '786 patent which can be read on the disclosure of the '090 patent.

Atlas Nineteenth Point: “The District Court erred in failing to hold the claims invalid as lacking invention over the plow of the '090 patent.”

It is clear from the context of the Atlas brief that the “Nineteenth Point” refers to claims of the '284 patent. This '284 patent was filed July 12, 1948, prior to the filing date of the '786 patent on August 14, 1948. Accordingly, the broad claims on the tractor mounted two-way plow are contained in the '284 patent, and not in the '786 patent. Claims 3, 8, 10 and 15 of the '284 patent were found to be infringed by the Atlas B-5 plow of

Exhibit 22 [Find. 33, R. 77].* Claim 10 is typical and is set forth below:

“10. In a two-way plow assembly adapted to be carried by a tractor, the combination of: a longitudinal beam extending in the direction of normal travel of the plow assembly, a cross-beam fixed to and intersecting the forward end of the longitudinal beam, a thrust-absorbing element removably mounted on the rearward end of the longitudinal beam, a carrier turnably mounted on the longitudinal beam between the cross-beam and the thrust-absorbing element, the carrier being provided with a right-hand plow and a left-hand plow angularly spaced substantially one-half revolution apart, power means including a double-acting hydraulic cylinder assembly on the cross-beam operatively connected to turn the carrier through substantially one-half revolution in either direction on the longitudinal beam to bring either plow into operative position, stop means on the cross-beam to limit turning movement of the carrier in either direction, and support means at the opposed ends of said cross-beam adapted to be carried by the tractor.”

This claim, as well as Claims 3, 8 and 15, cannot be read upon the disclosure of the '090 patent.

Atlas Twentieth Point: “The District Court erred in failing to hold the '284 patent invalid on the ground of double patenting.”

The validity of the '284 patent is challenged on grounds of double patenting with respect to the '090 patent and

*And indeed it was conceded [Trial Court Tr. p. 2699].

with respect to the '786 patent. The '090 patent was filed July 14, 1947. The '284 patent was filed July 12, 1948, and the '786 patent was filed August 14, 1948. The charge of double patenting with respect to the '284 patent fails because the claimed subject matter of the '284 patent distinguishes in a patentable sense from the claimed subject matter of the '090 patent. It is immaterial whether the broad claims of the early '090 patent can be read on the disclosure of the '284 patent. It is likewise immaterial to the validity of the '284 patent whether the claims of the later filed '786 patent can be read on the disclosure of the '284 patent. The double patenting problem does not arise merely because claims of the '090 patent dominate disclosures of the later patents, nor because claims of the '284 patent dominate the disclosure of the later filed '786 patent. In each case, the broad claims appear in the earliest filed application.

Even if it were true, and it is not, that Appendix E of the Atlas Brief shows that Claim 6 of the '786 patent reads on the disclosure of the '284 patent, this would be immaterial on the question of validity of the earlier filed '284 patent. Claim 6 of the '786 patent fails to read on the disclosure of the '284 patent because the latter lacks "pivot means for connecting the draft links to the ends of the cross bar". The pivot bolts 18 of the '284 patent do not connect the draft links or anything else to the ends of the cross beam 13. Appendix F correctly shows that Claim 15 of the '284 patent dominates the construction shown in the later filed '786 patent. This only means that the earlier filed patent contains the broad dominating claims, and the allegation of double patenting fails.

With regard to the charge of double patenting of the '284 patent with respect to the '090 patent, it is im-

material that claims of the '090 patent dominate the disclosure of the '284 patent. The broad dominating claims are in the earlier filed patent. However, Claim 3 of the '284 patent does not read on the disclosure of the '090 patent, because the '090 plow is supported on its own wheels and not on a tractor, and because the '090 plow does not have support means at the opposed ends of the cross member adapted to be carried by the tractor. Claims 8, 10 and 15 of the '284 patent distinguish over the '090 patent disclosure for the same reason.

Atlas Twenty-First Point: "The District Court erred in failing to hold the claims of the '089, '090 and '091 patents found to be infringed by Exhibit 18 invalid for failing to comply with 35 U. S. C. 112."

Atlas argues that all of the claims of the '089, '090 and '091 patents are invalid for overclaiming and for failing to particularly point out and distinctly claim the invention. To support this argument with respect to the '090 patent Atlas argues that Claim 6 is unpatentable over the prior art because each of the individual elements of the claim can be found in prior art patents. Certainly this is not the test. Each of the elements of the combination is assumed to be old and was so found by the trial court [Find. 41, R. 78]. Atlas argues that Claim 6 of the '090 patent is invalid under 35 U. S. C. §112 because Capon [R. 1399], Melotte, Exhibit A-66, Melotte [R. 1469], and Weyhmuller [R. 1495] show certain of the elements of the claim. For convenience, the claim is set forth below:

"6. In a two-way plow assembly, the combination of a frame, a tongue pivotally connected to the frame for relative lateral movement, a carrier mounted on the frame and provided with a right hand plow and

a left hand plow, *first power means on the frame for moving the carrier to bring either plow into operative position, second power means on the frame for shifting the tongue, and stationary power transmitting elements interconnecting said first and second power means for conjoint operation, whereby the tongue is shifted in response to movement of the carrier.*”

Not one of the references shows the subject matter contained in the italicized portion of the claim. Not one of them has the first power means on the frame for turning the carrier, the second power means on the frame for shifting the tongue, or the stationary elements which interconnect the two power means for conjoint operation.

The same objection is applied by Atlas to Claim 7 of the '091 patent. It likewise fails because the claimed combination is not present in the prior art. The '090 patent is not prior art as against the '091 patent since both issued on the same day.

Claim 12 of the '089 patent is also challenged. This claim includes the following requirements:

“arms pivotally mounted on the frame; means connecting the extending end of each arm to one of said supporting wheels; upright standards on the frame; pivot means on each arm intermediate the ends thereof; and upright power cylinder assemblies each operatively interposed between the pivot means on one of said arms and the upper portion of one of said standards for pivoting the upper arms relative to the frame.”

While this quoted portion of the Claim 12 is admittedly only a part of the combination claimed, the recitation in

the balance of the claim of the frame, supporting wheels, carrier, etc. is necessary to relate the parts which cooperate in the new combination.

The portions of the comments of the Trial Judge quoted by Atlas and torn from context are misleading. For example, just prior to the first quoted portion on page 2476 of the trial transcript, the Trial Judge said

“I think he had invention, I think that he got a combination here of all of these things that people had been trying to get—I do not think the Capon patent disclosed it. I don’t think Unterilp disclosed it; everything disclosed a little bit, but he put them all together in a workable plow that a farmer could make, and did make, and go out and plow ground with it. And that is what they were after, and that is what he got.”

Atlas Twenty-Second Point: “The District Court erred in failing to hold claims 6 to 9, 11, 13, 15, 16, and 20 to 24 of the ’090 patent found to be infringed by Exhibit 18, invalid on the grounds of lack of invention, and aggregation.”

Atlas first challenges the validity of Claims 6-9 and 20-23 of the ’090 patent and selects Claim 6 as being typical. Claim 6 is set forth in full under the discussion relating to the “Twenty-First Point” *Supra*. Atlas argues that the various elements of Claim 6 are found in Melotte [R. 1469], Melotte [A-66], Weyhmuller [R. 1495], defendant’s Exhibit B-9-a, York [R. 1328], Briscoe [R. 1382], Acton, [A-43-a], Wilson, [R. 1362], Capon [R. 1399], Chapman [R. 1299]. Of course, not one of these prior art references in itself provides a complete anticipation of Claim 6; otherwise Atlas would not have found

it necessary to list the other nine references. Moreover, not one of these references shows a two-way plow having power means on the frame for moving the carrier to bring either plow into operative position. Not one of these references shows a two-way plow having power means on the frame for shifting a tongue. And nowhere in this collection of references is found a two-way plow having these two power means interconnected.

Weyhmuller [R. 1495] is quoted as anticipating the interconnection feature but the quoted portion of this foreign patent comprises only a statement of what the prior art was believed to be at that time without showing such prior art in the drawings. Such a statement is not part of the disclosure of the foreign patent and it can have no anticipating effect.

“A foreign patent is to be measured as anticipatory, not by what might have been made out of it, but by what is clearly and definitely expressed in it. An American patent is not anticipated by a prior foreign patent, unless the latter exhibits the invention in such full, clear and exact terms as to enable any person skilled in the art to practice it without the necessity of making experiments.” *Carson v. American Smelting & Refining Co.*, 4 F. 2d 463, 465, 9th Circuit (1925).

Moreover, the language quoted from Weyhmuller would be satisfied by a device of the type shown in defendant's Exhibit B-9a wherein a transversely rotatable carrier was turned by forward motion of the plow frame and drag of the plows in the ground on manual release of a catch. No power cylinder was involved for rolling the carrier or for shifting the tongue.

The Chapman patent [R. 1299] shows how far afield Atlas has gone in trying to anticipate the claims of the Pursche patents in suit. Not even Atlas would allege it was following the teachings of this Chapman patent. The truth is, of course, that Atlas built the Pursche plows under license then cancelled the license and stopped paying royalties, and continued to make the same plows.

Several misstatements of fact appear in the Atlas brief under the "Twenty-Second Point". Capon [R. 1399] does *not* have a lift means for the frame. Claim 16 is not the same as Claim 24; the tail wheel of Claim 16 is required to roll on unplowed ground for both positions of the carrier, whereas Claim 24 would dominate a construction using two tail wheels on one assembly, one being used with the right-hand plows and the other being used with the left-hand plow. Such latter construction is used by Pursche's non-exclusive licensee, International Harvester Company, in the '210 plow, Exhibit 31.

Claims 11 and 13 are challenged on grounds they do not read on the drawings of the patent. The "cross-member" defined by these claims is shown at 21 in Figures 2, 11 and 12 of the patent drawings. The hydraulic power cylinder 45 is mounted on the cross-member 21. The "lift means" includes the mechanism for raising the frame on the wheels and includes the side members 19 and 20 (Figure 11). These side members are connected to the ends of the cross member 21. The claims thus read squarely on the drawings.

Claim 15 has been challenged as invalid over Chapman [R. 1299] or Melotte [R. 1469] and taken in view of Unterlip [R. 1494], but not one of these references shows "a tail wheel on the carrier adapted to roll on unplowed ground *adjacent said vertical standard.*" The purpose of

positioning the tail wheel adjacent the vertical standard is to provide support for the bank on which the tail wheel rolls. See discussion under "Twenty-Third Point".

All of the claims mentioned by Atlas under the "Twenty-Second Point" are charged to be invalid on the ground of aggregation, but no supporting argument is given. All of those claims except 13 are challenged on the ground of old combination. As set forth above, Weyhmuller [R. 1495] does not teach interconnection of a tongue shifting power cylinder and a carrier rollover power cylinder, and the old patent to Chapman [R. 1299] is substantially useless to show any combination set forth in these claims.

Atlas Twenty-Third Point: "The District Court erred in failing to hold the '091 patent invalid for double patenting under the '090 patent."

The '091 patent issued on the same day as the '090 patent. By the weight of authority, the doctrine of double patenting does not apply.

"Where both patents issue on the same day double patenting does not arise, according to the weight of authority", Amdur, Patent Office Rules and Practice, 1949, Section 79(e), citing *Deister Concentrator Co. v. Deister Mach. Co.*, 263 Fed. 706, C. C. A. 7, (1920).

In that case plaintiff sued on two patents relating to ore concentrating machinery. Both patents issued on the same day. Defendant argued that the later filed patent was invalid for double patenting and cited *Miller v. Eagle Lock Co.*, 151 U. S. 186. The Court said however,

"But there has been no double patenting in the present case. The two applications were copending.

* * * *The two patents were issued on the same day.*
(Emphasis added.)

A long line of decisions follows the position taken in the *Deister Concentrator* case. Thus, in *Therox Co. v. United States Industrial Chemical Co., Inc., et al.*, 14 F. 2d 629 (affirmed 25 F. 2d 387) it was stated, at page 640

“Since the patentee is the same in both instances, the second Schaub patent is not invalidated by the application for the first. *Deister Concentrator Co. v. Deister Machine Co.* (C. C. A.) 263 F. 710. It is true in the case at bar, as in the case cited, that although the claims in the second patent might have been joined with the claims of the first, no damage to the public resulted from their separate presentation, in view of their simultaneous issuance, and it is quite clear that no fraud was practiced or intended by the applicant.” (Emphasis added.)

Also in *Standard Brands Inc. v. Federal Yeast Corporation*, 38 F. 2d 329 at 344 D. C. Maryland (1930) the Court cited the *Diester Concentrator* case and held that patents issued on the same day were not void for double patenting.

In *Glen Raven Knitting Mills, Inc. v. Sanson Hosiery Mills, Inc., et al.*, U. S. D. C. N. D. North Carolina (1950) defendant argued that one design patent was invalid over another design patent issued the same day. The court said

“There is no merit in the contention of double patenting Bley patents, design Nos. 151,732 and 151,733 were issued the same day on applications filed the same day; * * * Companion patents issued

on the same day which expire on the same date, do not prolong the life of either. *United States Industrial Chemical Co. v. Theroz Co.*, 4th Cir. 25 F. 2d 387. *No damage results to the public from the simultaneous issuance of patents.* *Deister Concentrator Co. v. Deister Machine Co.*, 7th Cir. 263 Fed. 706." (Emphasis added.)

In *E. J. Brooks Co. v. Stoffel Seals Corp.*, U. S. D. C. S. D. N. Y. (1958), 160 Fed. Supp. 581, 588, it is stated

"In this case there would appear to be no issue of extension of the patent monopoly, or double patenting, since both patents were issued to the common assignee on the same day."

All of the Pursche patents in suit were copending and each patent refers to all of the earlier filed patent applications. In this situation §120 of 35 U. S. C. applies:

"An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States by the same inventor shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application."

Moreover, not one of the claims of the '091 patent can be read upon the disclosure of the earlier filed '090 patent, and no claim in the '091 patent is directed to the

same invention as any claim in the '090 patent. Claim 15 of '091, referred to in the Atlas brief, requires that the tail wheel roll on unplowed ground adjacent the vertical standard which connects landslides of the right hand plow and the left hand plow. The purpose as set forth in the objects of the invention of the '091 patent (Column 1) lines 19-22,

“the tail wheel being positioned adjacent the standard for the plow runners so that the bank which the tail wheel rolls upon is adequately supported”

and as set forth in Column 4, lines 28-30,

“in order that the standard and the lower landslide may support the unplowed ground on which the tail wheel rolls.”

The '090 patent does not show this feature and there are no claims directed to it. The tail wheel 18 of '090 patent is positioned to the rear of the rearmost vertical standard and hence the ground upon which it rolls is not supported by the vertical standard. Claim 3 of the '090 patent referred to in the Atlas brief has nothing to do with this feature.

Similarly, Claims 7 and 8 of the '091 patent referred to in the Atlas brief both require that the tongue have a direct pivotal connection with the stationary longitudinal beam member. This is provided by the pins 82 fixed to the stationary beam 19 as shown in Figure 8 of the '091 patent. In the '090 patent, on the other hand, the tongue 70 is connected by a pivot pin 73 to the bracket 74 and the channels 22 and 23. This is clearly shown in Figure 8 of the '090 patent. The heavy draft loads carried by the tongue 50 are therefore applied to the housing 74 and to the channel parts 22 and 23 of the frame.

The construction of the '091 patent is superior from the standpoint of applying the heavy draft load directly to the longitudinal beam rather than through other parts of the frame of the machine. Thus, the structure and the advantages to which claims 7 and 8 are directed are totally absent in the disclosure and claims of the '090 patent.

Underwood v. Gerber, 149 U. S. 224, relied upon in the Atlas brief makes no mention of "double patenting" in either the trial court opinion or in the opinion on appeal. The Underwood decision has been followed or cited with approval only in cases involving disclaimers. No such issue is involved in the present litigation.

In the cases of *Miller v. Eagle Manufacturing Co.*, 151 U. S. 186, *McCreary v. Pennsylvania Canal Company*, 141 U. S. 459, *Weatherhead Company, et al., v. Drillmaster Supply Company, et al.*, 227 F. 2d 98, the patents did *not* issue on the same day, and hence these cases are not in point.

Atlas Twenty-Fourth Point: "The District Court erred in failing to find claims 6 to 9 and 14, 15 and 22 of the '091 patent found to be infringed by Exhibit 18 invalid over the prior art."

Since the '090 and '091 patents issued on the same day, they may be treated as a single patent and the required differences between the claims are the same as if they were all in the same patent. Atlas compares Claim 9 of '091 patent with Claim 6 of the '090 patent. However, Claim 9 of the '091 patent requires

"pivot means connecting the outer ends of the bifurcated portion of the tongue to the frame, a roller on the tongue adapted to roll on the arcuate front member,"

There is nothing in the '090 patent or in Claim 6 thereof relating to such construction. In the '090 patent the front member is not arcuate, the tongue is not pivoted at its bifurcated end, and the tongue does not have a roller contacting the arcuate front member. Claim 6 of '090 is set forth *supra* in remarks concerning the "Twenty-First Point" and is directed to an entirely different combination including

"stationary power transmitting elements interconnecting said first and second power means for conjoint operation, whereby the tongue is shifted in response to movement of the carrier."

None of the references listed in the Atlas brief teaches the combination set forth in Claims 6-9, 14, 15 and 22 of the '091 patent. The tongue 110 of Orelind [R. 1386] is not bifurcated and does not straddle the arcuate frame member 109.

The Atlas allegation that Claims 6-9 are invalid on Capon, [R. 1399] seems almost incredible.

Claims 6, 7 and 8 require that the tongue be pivoted directly to the longitudinal beam member but Capon's tongue 51 is connected at 50 to cross shaft 49, spaced below the forward end of the beam 1, as shown in Figures 4 and 5 of Capon. Claims 6-9 require an arcuate front member on the frame and power means for swinging the tongue but Capon shows neither of these requirements; the tongue is shifted by the hand lever 56 and the arcuate gear segment 53 is not on the plow frame but on the pivoted draft assembly 52.

The similarity of Claim 14 and Claim 6 in the same '091 patent has no bearing on the validity of either claim. Admittedly they should stand or fall together, but the

validity of Claim 6 or Claim 14 has not been successfully challenged.

Claim 15 of the '091 patent is charged to be invalid "over the prior use of the '090 plow" but that plow was first used in 1947, and the '091 patent was filed in October of 1947. Use within a year prior to the filing date is not a prior public use. Moreover, Claim 4 of the '090 patent is directed to a combination including a "third supporting wheel rolling upon unplowed ground when either plow is in plowing position", while Claim 15 of the '091 patent requires a vertical standard connecting plow landslide positioned so that the tail wheel rolls adjacent thereto. The purpose, as pointed out above, is to provide support for the land on which the tail wheel rolls. These two claims accordingly do not cover the same substance. The Atlas argument certainly goes far afield alleging that Claim 15 is invalid over Chapman [R. 1299] or Chapman [Ex. A-1-b].

Claim 22 is not like Claim 14 because it differs in important and material aspects. It cannot be read on the prior art references set up by Atlas against Claim 6 or Claim 14.

Atlas Twenty-Fifth Point: "The District Court erred in failing to hold claims 6 to 9, 14, 15 and 22 of the '091 patent invalid on the ground of aggregation."

None of the claims of the '091 patent are invalid on the ground of aggregation. As found by the Trial Judge [Find. 45, R. 80].

"The elements of the combinations of Claims 6, 7, 8, 9, 14, 15 and 22 of Patent No. 2,625,091 perform additional and different functions in combination than they perform out of combination, to wit:

they provide direct application of draft force directly to the longitudinal beam which supports the plow carrier thereby reducing draft force stresses in the remainder of the frame, and they provide for mounting scraper blades on the plow carrier in advance of the plows so that trash may be cut by the scraper blades and buried by the plows in a single plowing operation and with either right-hand or left-hand plows in operative position.”

Atlas Twenty-Sixth Point: “The District Court erred in failing to hold claims 12 to 16 of the '089 patent found to be infringed by Exhibit 18 invalid for double patenting.”

Claim 19 of the '089 patent referred to in the Atlas brief (but not charged to be infringed) includes among other things,

“an actuator element attached to the draft tongue adapted to actuate the latch means”

This actuator element is No. 88 and is clearly shown in Figures 6, 8, 9 and 10 of the '089 patent. A power cylinder 93 acts on this member 88 to shift the tongue 50 as well as to operate the carrier latches 76 and 77. There is nothing in the '091 patent comparable to the cross bar actuator 88 of the '089 patent. The Atlas brief does not even allege that Claims 12 to 16 of the '090 patent are directed to the same invention as the Pursche patent '091. Claims 12 to 16 are directed to the combination including the so-called “A frame” construction, and none of the other Pursche patents disclose or claim such a construction.

Since the '089 and '091 patents issue on the same day, the defense of double patenting does not apply. *Deister*

Concentrator Co. v. Deister Mach. Co., 263 Fed. 706, C. C. A. 7, (1920). See the discussion of the law on double patenting, *supra*, under comments on the Atlas "Twenty-Third Point."

Atlas Twenty-Seventh Point. "The District Court erred in failing to hold claims 12 to 16 of the '089 patent invalid over the prior art."

Contrary to the statement in the Atlas brief, the A-frame construction for raising and lowering a two-way plow frame with respect to its ground wheels is not shown in the Atlas Scraper Wagon [R. 1608]. The A-frame in that device is attached to the scraper bowl which swings up and down between the side bars of the main frame, and the main frame is supported on wheels which cannot be moved up and down relative to it. The A-frame is not on the main frame of the device, but constitutes only an extension of the scraper bowl. Strictly speaking, the A-frame itself is not new but this is true of all of the other elements in the combination claimed. It is certainly not apparent how the A-frame on the scoop bowl of the wagon scraper [R. 1608] could be combined with the Melotte Patent [R. 1469] to anticipate any claims in the '089 patent.

Atlas Twenty-Eight Point: "The District Court erred in failing to hold claims 12 to 16 of the '089 patent invalid on the ground of aggregation."

Claims 12 to 16 of the '089 patent are *not* invalid on the ground of Aggregation or Old Combination. The elements of these claims perform additional and different functions in combination than they form out of the combination, to wit:

"they provide a direct acting hydraulic power connection between the frame and the wheel arms to

form a compact unit eliminating intermediate parts between the hydraulic cylinder assembly and the respective wheel arms.” [Find. 42, R. 79].

Atlas Twenty-Ninth Point: “The District Court erred in finding, concluding and adjudging that it had jurisdiction under 28 U. S. C. A. 1338(b) of the claims for unfair competition.”

Atlas Thirtieth Point: “The District Court erred in failing to find and hold that the proof of the claims for patent infringement involved almost nothing that was relevant to any of the alleged claims for unfair competition.”

“The Court has jurisdiction of the claim for Unfair Competition because it is joined with the related claim under the patent statute, United States Code 28, Section 1338(b).” [Concl. of Law XXVIII, R. 95].

The motion by Atlas before trial to dismiss Pursche’s cause of action for Unfair Competition for lack of jurisdiction was denied by the trial Court. In the memorandum filed April 24, 1957 the Court said:

“To hold that the non-federal cause of action of unfair competition must ‘rest upon substantially identical facts’ (*Landstrom et al. v. Thorpe et al.* (1951, 8th Cir.) 189 F. 2d 46) would narrow and restrict the statute, and in my judgment, is contrary to the plain words of the statute and the obvious intent of Congress. From reading the Complaint and the Answers and the Cross-claim, *much of the proof on one claim would have to be duplicated at another trial on the other claim in another forum*; and where that is

so, the provisions of the statute giving jurisdiction to a 'substantial and related claim' is met." (Italics added.)

The above quoted ruling of the Court was proved to be correct in the course of the trial because much of the proof of the claim for patent infringement was the same as the proof of the claim for unfair competition. Thus, proofs of the following material points related to both claims:

1. The construction and operation of the plows of the plows of the five Pursche patents in suit, including a field demonstration of full size plows. (Witnesses: Harry A. Pursche, Claude B. Ogle, Sr., Roy C. Pursche, Willis L. Miller, Edgar E. Cox, George Ogatta, Leslie I. Phillips, and Clarence T. Fishleigh.)
2. The inventions contained in the patents in suit, as distinguished from the prior art:
 - (a) Long felt want.
 - (b) Unsuccessful experimentation.
 - (c) Commercial success and adoption by the industry.
(Witnesses: Harry A. Pursche, Claude B. Ogle, Sr., Clarence T. Fishleigh.)
3. The Atlas plow of Exhibit 18, first made under license, combined inventive features from the '089, '090 and '091 patents. (Witnesses: Harry A. Pursche, Claude B. Ogle, Sr., Claude B. Ogle, Jr., Clarence T. Fishleigh.)
4. The Atlas tractor mounted plows B-5 of Exhibit 22 used inventive features of the '090, '786 and

'284 patents. (Witnesses: Harry A. Pursche, Clarence T. Fishleigh.)

5. The question of infringement of the Atlas wheel carriage plows of Exhibits 20, 21 and 23 (Witnesses: Harry A. Pursche, Clarence T. Fishleigh, Claude B. Ogle, Sr., Claude B. Ogle, Jr.)

The five material points listed above are important in the proof of the unfair competition cause of action because they show that the plows which Atlas continued to manufacture and sell after the termination of the license agreement with Pursche embodied the inventions which Pursche disclosed to Atlas. This continued use by Atlas after termination of the agreement of the benefits of the Pursche license, and the continued manufacture and sale of the same plows for which royalty was formerly paid to Pursche forms an important part of the pattern of activity of Atlas which constituted unfair competition.

The test for joining the action for patent infringement with the action for unfair competition as stated by Judge Jertberg in *Falcon Products v. Hollow Rod Sales & Service Co.* (D. C. Cal.) 135 Fed. Supp. 91, requires that the two claims:

“have a common background of basic facts and that substantially the same evidence will apply to both”. As shown by the five material points in the above list, this test has been met.

The other cases cited in the Atlas brief under the "Twenty-Ninth Point" are as follows:

Dubil v. Rayford Camp & Co., 184 F. 2d 899,
method patent and trademark infringement.

Landstrom et al. v. Thorpe et al. (C. A. 8) 189 F.
2d 46. Trademark infringement and unfair com-
petition. (The trial court referred to this case
and refused to follow it saying that it "would
narrow and restrict the statute".)

Hook v. Hook & Ackerman, Inc., (233 F. 2d 180)
Trademark infringement and unfair competition.

Accordingly, the only case cited by Atlas under the "Twenty-Ninth Point" in which unfair competition (with-
out trademark infringement) and patent infringement
were involved was *Falcon Products v. Hollow Rod Sales
& Service Co.*, *supra*. The test for joinder as set forth
in that case by Judge Jertberg is believed to be correct,
and the present case meets that test.

Atlas Thirty-First Point: "The District Court erred
in failing to find and hold that a failure to assign patents
under a licensing agreement does not constitute the tort
of unfair competition and is actionable only in contract."

In the Atlas pattern activity which was held to con-
stitute unfair competition, the failure of Atlas to assign
to Pursche "inventions, improvements, modifications and
betterments" as required by the Pursche-Atlas license
agreement was only one item, and that item was coupled
with "the attempt to evade this requirement by conceal-
ing from and failing to disclose" such matters to Pursche.

[Concl. of Law XXXII, R. 96]. Other items in the Atlas pattern activity and whole manner of doing business were “concealing and failing to disclose” to Pursche development activities as required. [Concl. of Law, XX-IX, R. 95], concealing from Pursche the “filing of patent applications in the name of its employee, Roy L. Chandler”, [Concl. of Law XXX, R. 96] “the continued use by the party Atlas Scraper and Engineering Co. of developments of Roy L. Chandler so withheld”, [Concl. of Law XXXIII, R. 97] the acts of the party Atlas “in filing patent applications in the name of Roy L. Chandler, and Roy L. Chandler and another, on inventions, improvements, modifications or betterments belonging to the party Harry A. Pursche” [Concl. of Law XXXIV, R. 97], all at the sole cost and expense of Atlas [Concl. of Law XXXV, R. 97] and prepared and filed by attorneys for Atlas [Find. of Fact 68, R. 86], the prosecution by Atlas of an interference proceeding in the United States Patent Office against Pursche, [Find. of Fact 65, R. 85] and the finding that Atlas “held out to the trade and to the purchasing public that the rollover plows which were offered for sale under the agreement, Exhibit 7, [B-19], were the development and invention of Harry A. Pursche.” [Find. of Fact 84, R. 90].

Under California law as set out in *Seagren v. Smith*, 63 Cal. App. 2d 733, Calif. Dist. Court of Appeal (1944), a licensee who pays royalties under a patent license for manufacture and sale of the patented devices cannot cancel the license and thereafter continue to manufacture and sell the same identical devices. The patent owner licensed a manufacturer to build patented gear pumps on a royalty basis and the parties operated under that agreement for three years. The manufacturer cancelled the li-

cense agreement by notice in writing but continued to make and sell the same gear pumps. On appeal the patent owner was awarded damages corresponding to royalties accruing after cancellation of the license agreement. The Appellate Court said

“the licensee saw fit to cancel the contract and continued to manufacture and sell the pumps to the detriment of licensor”.

The Court held that the manufacturer was liable to the patent owner

“upon the theory of implied contract based upon the well recognized and settled principal that a person shall not be permitted to enrich himself unjustly at the expense of another”.

Summarizing the entire pattern of activity of Atlas, in continuing to accept the advantages and know-how gained during the period that the license was in force and continuing to manufacture and sell the same plows without payment of royalty, and holding out to the public that the plows were developed by Pursche, and in setting up the straw man Chandler in an obvious sham to avoid its obligations to Pursche—these constituted the behavior which the Trial Court found comprises unfair competition.

Atlas Thirty-Second Point: “The District Court erred in holding that Atlas is guilty of unfair competition.”

Contrary to the statement by Atlas Findings 81, 82, 83 are fully supported by the evidence, as will appear in the comments below on the “Thirty-Third” to “Thirty-Ninth” points.

With regard to the “unless clearly erroneous” rule, the late Judge Lemmon of this Court said in *Hunter Douglas*

Corporation v. Lando Products, Inc., (9th Cir.) 1956, 235 F. 2d 631,

“Strong almost to the point of vehemence is the expression ‘clearly erroneous’. An appellate court should bear this in mind when it applies Rule 52(a) of the Federal Rules of Civil Procedure, 28 U. S. C. A. which provides that ‘In all actions tried upon the facts without a jury *** (f)indings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses’.”

Atlas Thirty-Third Point: “The District Court erred in failing to hold there was no violation of Paragraph IX of the License Agreement and no unfair competition with Pursche by failure or refusal of Atlas to assign the chain type tail wheel, Exhibit 42 or the rollover mechanism, Fig. 6 of the patent, Exhibit AR, for the reason that these two structures were conceived after the date of termination of the Pursche-Atlas License Agreement.”

The Atlas employee Chandler was named as inventor in four patent applications filed by Atlas, as shown on the chart below:

| <u>Date Filed</u> | <u>Exhibit No.</u> | <u>Patent No.</u> | <u>Feature</u> |
|-------------------|--------------------|--|---|
| 5/29/52 | 44 | 2,817,241 | Improved gear type rollover mechanism |
| 2/2/53 | 51 | Ser. No. 334,578 (Since trial date has issued as Pat. #2,842,038) | Butterfly type tail wheel (involved in interference with Pursche) |
| 11/30/53 | 42 | 2,773,439 | Chain type tail wheel |
| 4/19/54 | AR (Fig. 6) | 2,830,519 | Two-way plow with gear type rollover mechanism |

The first three *Chandler* cases listed in the above table were not assigned to Atlas, but were the subject of an exclusive license agreement between Chandler and Atlas, Exhibit 43-a, R. 1683. The first two items in the above table represent work performed by Atlas during the time that the license agreement with Pursche was in force. Thus, Item 1 was filed during the term of the license agreement, and Item 2 was the subject of an interference proceeding between Pursche and Chandler in which Chandler proved construction and operation of his device in February and March of 1952 [R. 1594, 95], during the term of the license agreement. It follows that these first two items represent undeniable violations by Atlas of Paragraph IX of the Pursche-Atlas agreement [R. 1651]. The last item in the above table, Patent 2,830,519, was assigned outright to Atlas, and was not the subject of any license agreement. *The scheme is clear; Atlas took by assignment inventions of its employee except where it would be obligated to assign such inventions back to Pursche under the terms of the Pursche-Atlas license agreement.* The trial judge was therefore certainly justified in concluding that all of the so-called Chandler inventions appearing in the Atlas-Chandler license agreement, [Ex. 43-a, R. 1683] were developed by Atlas during the term of the Pursche-Atlas agreement. The trial court concluded that the actions of Atlas in making a special case of the so-called Chandler inventions to circumvent the provisions of the Pursche-Atlas agreement carried more probative force than the denials of Chandler and Ogle.

The gear type rollover mechanism shown (but not claimed) in the last item listed, the two-way plow of Patent 2,830,519 (Figure 6) is clearly the same mechan-

ism shown in Exhibit 46 developed by Chandler around the middle of 1951 [R. 584].

This was the evidence to support Finding 81, R. 89. Atlas has not shown that the trial court was “clearly erroneous” in making this finding.

Atlas Thirty-Fourth Point: “The District Court erred in finding that Chandler was employed by Atlas as an engineer and designer and in failing to find that he was employed as a draftsman.”

While Chandler was employed by Atlas he was named as inventor in the four separate patent applications tabulated under the “Thirty-Third Point” above, which patent applications are all directed to improvements in the main-line “bread and butter” items manufactured and sold by Atlas. He accompanied the first production model of the plow of Exhibit 51 at the demonstration held in Merced, California in March 1952, [R. 1594]. Chandler testified [R. 570] that he made field service calls. Significantly, he testified “I was assigned to the duty along with Bud Ogle, (Claude B. Ogle, Jr.) of designing a new HD and SD plow.” In other words, he was given the responsibility along with the son of the president of Atlas, for developing a new line of two-way plows. Chandler also testified [R. 570], “I was assigned the duty in 1953 of making a high clearance grade marker for one of Atlas’ customers in Oxnard.”

With this evidence before him, the Trial Court was fully justified in finding that Chandler was not a mere draftsman but that he was an engineer and obligated to assign his inventions to his employer which came within the scope of his duties.

Atlas Thirty-Fifth Point: “The District Court erred in failing to find that the inventions of Exhibits 42, 44 and 51 were conceived by Chandler on his own time and not in connection with any assignment by Atlas.”

Chandler lived in a house trailer on the Atlas property behind the drafting office [R. 583].

The three patent applications of Exhibit 42, 44, and 51 were filed by Atlas [R. 67] and all costs of filing and prosecution of the patent application were paid by Atlas [R. 67]. Atlas treated the applications as if they were its own. The Atlas attorneys handled the domestic and foreign patent applications and all copies, letters, reports, and bills were sent to Atlas and not to Chandler [R. 601, 608]. At the trial, Chandler didn't know the number of foreign patents filed by Atlas in his name [R. 610]. All of the engineering work in developing the designs and adapting them to commercial use was done by Atlas employees [R. 635]. The actual construction of the devices forming the first reductions to practice was done at the sole cost and expense of Atlas [R. 635]. It seems remarkable, to say the least, that Chandler first conceived each of these ideas relating to his employer's business, either in the Atlas drafting room after hours or in his own house trailer parked adjacent the drafting room. Even if this be true so far as the conception is concerned, the inventions belong to Atlas because they related to the business to which the employee-engineer's duties were assigned, and because the engineering design and construction work in reducing the invention to practice was done at the sole cost and expense of Atlas.

Chandler was a straw man set up by Atlas in a transparent manoeuver to cheat Pursche of his rights under the Pursche-Atlas agreement. On the first Chandler in-

vention developed *after* the termination of the Pursche-Atlas agreement, Exhibit AR, Patent 2,830,519. Chandler assigned his rights to Atlas in the normal fashion, as there was no occasion to continue the subterfuge.

Atlas Thirty-Sixth Point: “The District Court erred in failing to hold that under the facts and law the Chandler inventions of Exhibit 42, Exhibit 44 and Exhibit 51 are his sole and exclusive property.”

As stated in *Forberg v. Servel, Inc.*, 88 Fed. Supp. 503, 509, U. S. D. C., S. D. N. Y. (1949),

“The question whether plaintiff was employed to invent is a question of fact. *E. F. Drew & Co. v. Reinhard*, 2 Cir. 170 F. 2d 679. Here the evidence does not justify a finding that at first plaintiff was so employed * * *. But when * * * his superior, told him * * * to solve a particular problem, he became employed to make an invention, if an invention would solve the problem, even though he had not been so employed originally. *Houghton v. United States*, 4 Cir. 23 F. 2d 386-390, Cert. Denied. 277 U. S. 592, 48 S. Ct. 528, 72 L. Ed. 1004. Having been so employed *his invention became the property of his employer and he was bound to assign it and any patent obtained thereon, to his employer.*” (Italics added.)

As stated in *North American Philips Co., Inc. v. Brownshield*, 111 Fed. Supp. 762, 765, D. C. S. D., N. Y. (1953),

“The defendant was engaged and paid to make specific improvements to the assembly. *He claims that he made the invention at his home at night, that he was directed by plaintiff to make improvements only to the box part of the assembly*

and not to the loop. However, the reliable evidence, * * * discloses that he * * * did so in the course of his employment at the plaintiff's plant. Under such circumstances, plaintiff is entitled to the invention, if any, and to any patent embodying such invention." (Italics added.)

The plow of Exhibit 51 tested by Atlas at Merced, California in March 1952, [R. 1594] embodied both the butterfly tail wheel invention and the gear type rollover mechanism shown in Figure 6 of Exhibit AR, Patent 2,830,519. Both of these devices constituted projects which Chandler had been assigned by Atlas to work on and develop. They were important jobs relating to improvements in essential parts of the principal products manufactured by Atlas. Chandler could not have worked on these projects unless he had been assigned to work on them.

Atlas Thirty-Seventh Point: "The District Court erred in finding that Atlas filed the applications of Exhibits 42, 44 and 51 in Chandler's name in an attempt to circumvent the requirements of the Pursche-Atlas License Agreement and evade the obligation of assignment of title to Pursche, and in failing to find that Chandler filed the applications in his name because he was the inventor and by law patent applications must be filed in the inventor's name."

Under Paragraph IX of the Pursche-Atlas license agreement [R. 1651] was the requirement

"Atlas agrees * * * to promptly and fully disclose to Pursche any and all inventions and improvements, modifications and betterments, made, discovered or acquired by Atlas * * * relating to the plow

construction forming the subject matter of this agreement; and any and all such inventions, improvements, modifications and betterments upon the aforesaid plow construction made during the life of this agreement by or through the efforts of Atlas * * * or coming under the control of Atlas * * * shall belong to Pursche whether patentable or not and shall be promptly assigned to Pursche by Atlas * * * .”

The license agreement thus obligated Atlas to *disclose* promptly to Pursche the inventions made by its employee Chandler in the course of his duties. Instead of making such disclosure Atlas filed patent applications on the invention without advising Pursche. The Court held that this was an attempt to circumvent the requirements of the Pursche-Atlas license agreement and to evade this obligation of assignment of title to Pursche. It is true that only the inventor can sign the patent application. Atlas should have made prompt disclosure to Pursche of each of the Chandler inventions. Instead, it took steps to circumvent and to evade the requirements of the license agreement with Pursche. Finding 67, [R. 86] is not erroneous and should not be set aside.

Atlas Thirty-Eighth Point: “The District Court erred in finding that Atlas in failing and refusing to carry out its obligations under the Pursche-Atlas Agreement and assign the Chandler inventions of Exhibits 42, 44 and 51 constitute unfair competition and in failing to find that Atlas never had any right to assign said inventions.”

Atlas Thirty-Ninth Point: “The District Court erred in finding that it is unfair competition for Atlas to continue to use, and in adjudging that Atlas cannot without permission of Pursche use the inventions of Exhibits 42, 44 and 51 for the reason that this constitutes an

adjudication of Roy L. Chandler's right without his being a party to this litigation in violation of the 'Due Process of Law' requirement of the Fifth Amendment."

Atlas had the right to compel an assignment to it of the inventions of Exhibits 42, 44 and 51, just as it had the right to compel the assignment of Exhibit AR, Chandler *et al.*, Patent 2,830,519.* Instead Atlas demanded no assignment although it treated the patent applications as if they were its own, and paid for all engineering work and actual construction of the devices. There is no evidence that Atlas ever made a request of Chandler to assign, and it was not until the Pursche-Atlas litigation reached the stage of pre-trial in November 1957 that any written agreement was entered into between Chandler and Atlas. Atlas deliberately avoided taking an assignment from Chandler in order to prevent Pursche from acquiring rights pursuant to the Pursche-Atlas agreement. Atlas having elected to give the inventions to Chandler, instead of demanding assignments so that the inventions could be transferred to Pursche as required by the agreement, now complains that Chandler has been "deprived of property rights under his patents without due process of law." The trial Court did not order Chandler to make any assignments. Chandler was the inventor, but he was not the owner of the patent rights.

By the terms of the Chandler-Atlas agreement, Article IX, [R. 1688] Atlas has the unrestricted right to cancel the license agreement:

"Atlas shall have the sole right of termination of this agreement, and upon termination of this Agree-

*Other Chandler *et al.* patents assigned to Atlas and issued since the beginning of the trial are #2,882,979, filed July 22, 1954, and #2,883,773, filed August 22, 1955.

ment for any reason, there shall be no implied licenses or implied obligations between the parties, and no acts committed by Atlas, its officers or agents prior to the termination of this Agreement, shall be construed as admissions relative to the ownership, rights, validity or scope of Chandler's patent rights."

Atlas need only exercise this right of cancellation in order to return full rights to the inventions to Chandler.

Atlas Fortieth Point: "The District Court erred in failing to hold that Pursche is entitled to no relief because he comes into Court with unclean hands."

Pursche testified [R. 294, 683] that in the latter part of 1948 or the first part of 1949 he made an oral disclosure to Mr. Ogle (Claude B. Ogle, Sr.) of the construction of the butterfly tail wheel, Exhibit 51, at the Atlas plant. An Atlas salesman told Pursche that Atlas two-way plows in use in the Lancaster area were not able to plow shallow enough. Pursche went to a plow standing at the paint rack and explained to Mr. Ogle how two arms should be added at the thrust collar with an adjusting screw on each arm. The tail wheel would swing from side to side, underneath each of these arms.

Pursche did not file a patent application on the idea until he saw his invention embodied in an Atlas plow some time later. His patent application Serial No. 323,200 became involved in an interference proceeding in the Patent Office, and the other application was the Chandler case, Serial No. 334,578. Although Pursche was the first to file he lost the interference to Chandler because Pursche could not prove that he gave the idea and full description to Mr. Ogle, who denied it. Under the

law, "the date of (that) conception cannot be fully proved by the oral testimony of the conceiver." (Citing cases.) Walker on Patents, Dellers Edition, 1937, page 218. Pursche therefore could not prove conception at the time of his disclosure to Ogle. Moreover, he could not prove reduction to practice because Pursche had not constructed one of the devices prior to filing his patent application. Accordingly, in the preliminary statement filed in the Patent Office in the interference proceedings, Pursche set forth the fact of his disclosure to Ogle [R. 1601] but was unable to offer any proof other than his own testimony. In the circumstances priority of invention was awarded to the junior party, Chandler [R. 1607].

Pursche did not take a false oath. He knew that he was the first inventor and had disclosed the idea to Mr. Claude B. Ogle, Sr. long before the idea was embodied by Atlas in a two-way plow. When he filed his application Pursche had no knowledge and no reason to believe that there would be a rival claimant to the invention.

There is absolutely no basis for any charge of unclean hands against Pursche.

Atlas "Forty-First Point" Through "Forty-Fourth Point".

These four points raised by Atlas all complain of alleged errors of the District Court in admitting and excluding evidence. The brief comments on these points are grouped together here since it is clear that none of them amounts to reversible error.

The Atlas objection to the admission in evidence of Exhibit 72, the written statement of the witness Lundie, is based solely on the ground that it was not proper cross-examination. But Lundie was in court and could readily

have been called under the adverse witness rule and the document Exhibit 72 would have been admissible without question.

The discovery depositions of Harry A. Pursche are contained in two volumes totalling 362 pages. The depositions also include forty Exhibits, many of them constituting multiple page documents or series of photographs. The entire file wrapper and contents of the six different patents originally in suit are among the deposition exhibits and these are the same as Defendant's Exhibits C, D, E, F, G and H in the trial court.

The Trial Judge refused to receive these voluminous discovery depositions into evidence because the witness Harry A. Pursche was before the Court:

“the witness is here and you can put him on the stand and ask him the same questions word for word if you want to.” [R. 702].

The trial Court also said:

“I still adhere to the view that if a witness is present and available, the witness should and must be used. Otherwise, you wind up by having trials by affidavits.” [R. 705].

“Mr. Whann: All right, sir. We will either work out an agreement with Mr. Lyon or we will have to put the witness back on for further examination.” [R. 705].

Later, Mr. Whann, counsel for Atlas, called Pursche to the stand and interrogated him about excerpts from his depositions [R. 1106 to R. 1111, R. 1123 to 1128, R. 1132 to 1133].

In view of these circumstances it is clear that the district court did not commit reversible error in excluding the depositions.

A total of forty-six still photographs were taken by a professional photographer in the course of the field demonstration put on by Atlas on March 19, 1958. These photographs were admitted into evidence as Exhibits RR 1-9, SS 1-9, TT 1-7, UU 1-4, VV 1-8, WW 1-9. The fifty foot length of eight millimeter film (25' split length-wise) has a running time of about four minutes.

The taking of the still photographs by the professional photographer was agreed upon in advance by all parties but there was no advance information or request for permission regarding the use of motion pictures taken sporadically by Claude B. Ogle, Sr. and the witness Fishleigh. The Court said:

“If there had been something said about taking pictures before and you had called attention to the fact that you wanted to get a picture of this operation, I could have settled it on the spot, whether it could be taken or was appropriate or was not appropriate, or some other operation should be taken. But in my judgment it is too piecemeal to be of any value either to this court or to the appellate court on review.” [R. 1009].

At best the motion picture film would be merely cumulative evidence. Clearly the District Court's ruling was not reversible error.

The telegram of the Exhibits 83(a) and 83(b) relate to the sale of model 210 International Harvester plows under its license [R. 1659] with Pursche. These telegrams stand on the same basis as Exhibits AL-1

to AL-12 which are royalty statements from International Harvester to Pursche. All of this material relates to commercial success of the Pursche patents in suit. The effect of the telegram was to bring the file of royalty statements Exhibit AL up to date as of the time of the trial.

Clearly the District Court did not commit reversible error in admitting these telegrams.

Conclusion.

The party Pursche respectfully submits that the District Court did not err in holding claims of the five Pursche patents in suit valid and infringed, and in holding that the District Court had jurisdiction of the claim for unfair competition, and in holding Atlas guilty of unfair competition.

Respectfully submitted,

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